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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,599	08/15/2001	Robert J. Feeney JR.	ONSITER.001A	1774

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,599

Applicant(s)

FEENEY ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 22, 23, 31-42 and 44-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 22, 23, 31-42 and 44-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, directed towards Claims 1-15, 22, 23, 31-42 and 44-52 in Paper No. 4 is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-15, 22, 23, 31-42 and 44-52 are rejected under 35 U.S.C. 102(b) as being anticipated by Liff et al. Liff et al. discloses the following.

As described in Claims 1, 22, 31, 35 and 44;

1. one or more dispensers (20) configured to controllably release a product in response to a control signal;
2. an admission subsystem (see element (311) and figure 13P) configured to maintain patient information;
3. a prescription subsystem coupled to said one or more dispensers and configured to:
 - a. receive entry of prescription information;
 - b. to relate patient information from said admission subsystem to the prescription information to initiate a determination of whether the product is appropriate for the patient;

- c. to send a control signal to said one or more dispenser units
to release the product;

(See col. 23, lines 12-37, which includes an adjudication step at line 16)

As described in Claims 2, 31, 35, 44 and 46;

- 4. said determination of whether the medication is appropriate for the
patient comprises a pharmacy adjudication (see col. 23, line 16);

As described in Claim 3;

- 5. said determination of whether the medication is appropriate for the
patient comprises a drug utilization review (DUR) (see figure 12, and
element (284);

As described in Claims 4, 32, 33, 36, 37 and 3;

- 6. said prescription subsystem is further configured to manage and
control a virtual inventory by tracking ownership and utilization of a
plurality of individually owned and co-mingled inventories in said one or
more dispensers (note that various inventories are kept track of, including
the inventory of several cabinets, and that virtual and actual inventories
are functionally equivalent to each other—also note that pharmaceutical
companies are also connected to the system, and they necessarily have
inventory systems of their own, which necessarily interface with the
system of Liff et al);

As described in Claims 5, 34 and 38;

7. access to a medication inventory is further controlled according to ownership of the medication as tracked in said virtual inventory (note that it is necessary for the medication to be matched with the appropriate patient and for medicines in a dispensing cabinet at hospital X to be identified as located at hospital X's cabinet);

As described in Claims 6 and 39;

8. said prescription subsystem is configured to manage and control a physical inventory by sending a reorder message to reorder a product when an inventory level is at a predefined level (note refill function (310), noting that pharmaceuticals are routinely given to patients with the number of refills located on the label, said refill occurring for a particular number of units of that pharmaceutical);

As described in Claims 7 and 40;

9. the predefined level comprises a par inventory level (note that it is well-known in the art to use predefined levels to trigger refills—see also figure 7C, element (182));

As described in Claims 8 and 41;

10. the predefined level comprises a dynamic par level that is based upon medical office product usage data (note that it is well-known and necessary for an inventory system to track inventory and inventory levels on a dynamic basis in order to perform adequate forecasting of needs);

As described in Claim 9;

11. said admission subsystem generates a patient specific drug benefit profile used in prescribing the medication (see elements (336, 337 and figure 13E);

As described in Claims 10, 23 and 51;

12. a sample management subsystem configured to track the distribution of a sample medication to a patient, to associate information gathered from the distribution of the sample medication with said patient information, to initiate a determination of whether the information is appropriate for the patient, and to send a control signal to said one or more dispenser units to release a sample medication (see figures 7B, 7C and 8);

As described in Claim 11;

13. a patient care subsystem configured to relate said patient information to data collected from the dispensing of an office administered medication and to send a control signal to said one or more dispenser units to release a product (see figure 2, elements (108 and 120);

As described in Claim 12;

14. an over-the-counter subsystem configured to relate said patient information to data collected from the dispensing of an over the counter product, further configured to send a control signal to said one or more dispenser units to release the over-the-counter-product (note that dispensing a prescription or over-the-counter drug is construed to be

handled in the same substantially the same fashion, using the same equipment and structure, therefore it is concluded that the system of Liff et al is capable of handling over-the-counter drugs);

As described in Claim 13;

15. the medication is dispensed at a point of care (note that the medication can be dispensed at a hospital or doctor's office, for example, and that any particular place, including a patient's home could conceivably be the location of a cabinet that is secure);

As described in Claims 14 and 44;

16. a central server (422) (see also element (573, figure 17, which indicates an internet which implies the presence of a server) connected via a network to said prescription subsystem and configured to receive and process said determination of whether the medication is appropriate for the patient;

As described in Claims 15, 42 and 45;

17. said central server is coupled to an enterprise resource planning (ERP) system having an accounting module configured to track finances and collection of money, an inventory module configured to manage physical and virtual product inventories, a purchasing module configured to automatically process purchase requests, and a fulfillment module configured to manage product order requests (note that at the very least,

these limitations are necessarily present, otherwise, the system of Liff et al would not work);

As described in Claim 47;

18. a user support module including user training and learning modules (note that a user support module, such as described in col. 11, lines 65-67 and col. 12, lines 1-14 would be expected to include learning and training modules);

As described in Claim 48;

19. said central system comprises a website connected to the central server, wherein said website is configured to provide controlled user access to system information (see figure 17, for example, which indicates use of the internet, and that the system of Liff et al would necessarily require a website in order to work);

As described in Claim 49;

20. said system information is able to be outputted in the form of a report (see figure 13Q, noting element(442));

As described in Claim 50;

21. a front office server coupled to said one or more dispensers and comprising an admission subsystem and said prescription subsystem, said front office server configured to serve patient information (note prior discussion on location of cabinets in a wide variety of places);

As described in Claim 52;

22. said central system performs system maintenance and monitoring
(see col. 11, lines 65-67 and col. 12, lines 1-14);

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)306-4195 for regular communications and (703)306-4195 for After Final communications.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Application/Control Number: 09/930,599
Art Unit: 3653

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Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3653



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SUPERVISORY PATENT EXAMINER
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March 2, 2003